

REMARKS/ARGUMENTS

Claims 1 - 15 are pending with claims 1, 10 and 11 having been amended and claims 12-15 having been added.

Summary of the Invention.

The present invention, in one embodiment, is directed to a pointing device on a remote unit that is configured to detect vertical motion to select functions on a display, and then to detect horizontal motion to select an amount of the selected function. The inventor does not claim to have invented the idea of having a menu of function items in one direction and selecting a quantity of that item in another direction. Prior art devices have similar menus. Rather, the invention involves the recognition that this can be done on a remote device by using a pointing element on that remote device, rather than using discrete buttons, touching a screen, or using a standard mouse. Using a pointing device rather than discrete button provides that a user does not need to repeatedly locate, such as by looking, buttons on a remote unit, but can locate the pointing device a single time and make menu selections based on different motions on the pointing device. Repeatedly looking at a remote unit to locate and press different buttons to make selections is not practical in low light, is not practical for users having poor eyesight, and is generally inconvenient and tedious.

Claims 1-4 and 7-10.

Applicant directs his comments to the most recent Office Action (dated 3/25/03) and Advisory Action (dated 7/14/03) for U.S. Patent Application 09/032,709 ("parent application") to which the present application claims priority. In the Office Action for the parent application, claims 1-4 and 7-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berstis (U.S. Patent No. 6,144,367) in view of Reddy (U.S. Patent No. 6,195,079).

Berstis.

Berstis does not show or suggest the invention as recited in claim 1. Rather, Berstis shows a multiple input computer display, in which joysticks can be used by two users to

manipulate graphical objects. These joysticks are 101 and 103 in Fig. 1A. Separately, Berstis shows a remote unit 106 that has a pointing device 147. Applicant is in agreement with the Examiner that Berstis's remote control unit has a pointing device. However, there is no suggestion that this pointing device is configured to select among menu items and then to select a quantity for such menu items in response to motion by an operator on the pointing device in two directions. Rather, separate buttons on the Berstis pointing device are used for providing selection purposes, such as the Back and Go buttons, and the Page Up and Page Down buttons. Therefore, Berstis's remote control does not provide the simplified operation of the pointing device of claim 1, but provides a complicated device that a user must repeatedly locate buttons on for operation. Accordingly, Berstis fails to teach, or even suggest, a pointing device configured to provide i) cursor movement, ii) selection of a menu item, and iii) selection of an aspect of a selected menu item. The Examiner acknowledges that Berstis fails to teach or suggest a pointing device configured to provide selection among menu items based on operator movement in a first direction and selecting an aspect of a selected menu item based on movement in a second direction, but alleges that Reddy supplies the missing teachings.

Reddy.

Applicant is in further agreement with the Examiner that Reddy shows in Fig. 7 a menu and in Fig. 8 shows an indicator for contrast values for the contrast item of the menu. However, Reddy's menu selections and control values are selected by pressing discrete buttons (Up and Down) on an interface input 106. The use of a number of buttons for menu selection requires the user to repeatedly locate the buttons, which is complicated and inconvenient for low light use and for use by people with poor eyesight. Accordingly, Reddy fails to teach, or even suggest, a pointing device configured to provide selection among menu items based on operator motion on the pointing device in a first direction and selecting an aspect of a selected menu item based on operator motion on the pointing device in a second direction. Both Berstis and Reddy fail to teach, or even suggest, the foregoing described features as recited in claim 1. Therefore, even if combined, Berstis and Reddy do not render claim 1 obvious.

Independent claim 10 recites similar limitations as in claim 1, and is not rendered obvious by Berstis and Reddy for at least the same reasons as those for claim 1. Therefore, independent claims 1 and 10 and claims 2-4, 7-9, and new claims 12-15 depending therefrom, are patentable over Berstis and Reddy.

Dependent claims 2-4, 7-9, and 12-15 are also patentable for reciting additional features. For example, regarding claim 2, because both Berstis and Reddy discuss the use of buttons that are pressed up and down for menu control. Neither of these references teaches, or even suggests, detecting motion on a pointing device in a first direction for function selection and detecting motion in a second direction for value selection. Berstis's and Reddy's buttons inherently have one motion detection direction and provide a single selection associated with the single motion detection direction. Because Berstis's and Reddy buttons inherently do not provide for motion detection in a second direction, these buttons cannot provide for value selection based on detected motion in a second direction. Therefore, Berstis and Reddy do not render claim 2 obvious.

Claims 5, 6 and 11.

Claims 5, 6 and 11 are not obvious on the basis of Berstis combined with Reddy, and additionally in view of Clark et al. As discussed above, Berstis and Reddy do not teach or suggest claim 1 from which claims 5 and 6 depend. Independent claim 11 recites similar patentable features not suggested in Berstis and Reddy. Clark is cited simply to show motion on a touchpad, and does not provide any teaching of the other elements as claimed, such as a pointing device configured to provide menu selection by operator motion in one direction and value selection by operator motion in another direction.

The touchpad in Clark allows input by an operator in two directions. However, Clark does not suggest providing the touchpad on a remote unit, and does not suggest providing menu selection and value selection by operator motion in two directions. As discussed above, the use of operator motion in two directions for menu selection and value selection provide benefits and convenience, especially for use in low light and for users having poor eyesight. Nothing in the cited references provides motivation to replace the button on Berstis and Reddy

with the touchpad of Clark. Federal Circuit "case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for showing of the teaching or motivation to combine prior art references," In re Dembiczak, 50 U.S.P.Q.2d, 1614, 1617 (Fed. Cir. 1999) (citations omitted). To guard against the tempting trap of hindsight, the evidence of a suggestion, teaching, or motivation to combine "must be clear and particular," Id. at 1617 (citation omitted). "Broad conclusory statements regarding the teachings of multiple references, standing alone, are not 'evidence,'" Id. (citations omitted). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability-- the essence of hindsight," Id. (citing Interconnect Planning Corp. v. Feil, 227 U.S.P.Q. 543, 551 (Fed. Cir 1985)).

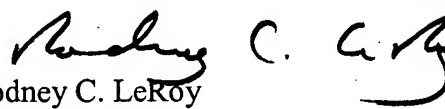
For at least the foregoing reasons, Applicant respectfully submits that claims 5, 6, and 11 are also patentable.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,


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